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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/755,541

01/05/2001

Anthony R. Rothschild

733755-6

5271

23879 7590 02/28/2008  
O'Melveny & Myers LLP  
IP&T Calendar Department LA-1118  
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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

02/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/755,541

Applicant(s)

ROTHSCHILD, ANTHONY R.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 62-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The evidence as a whole, including the papers filed 7/9/2007 do not show evidence of conception for all of the claims. The following conception issues still remain:

- Each of the independent claims is broad enough (personal communication, electronic communication) to cover embodiments disclosed at filing such as chat, IM, SMS, which have yet to be demonstrated to have been conceived by applicant prior to the date of the references. Applicant should limit each independent claim to an email communication.
- Claims 66, 78, the email server is able to format the communication in a plurality of different formats. This is not present in applicant's conception evidence.
- Claim 67, 71, identifying the formatting requirements for recipient's device and formatting accordingly. This is not present in applicant's conception evidence.

As stated previously, each dependant claim must also have evidence of prior conception and where conception is lacking, the rejection for such a dependant claim remains proper, even if conception has been proven successfully for its parent independent claim.

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Applicant's declaration under 37 CFR 1.131 (with supporting evidence) has been considered but is ineffective to overcome the rejections of the above claims relying on the Stanbach, Jr. et al (US6449657), KR99073076A and Camut et al (US6684257) references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Moving to the issue of diligence, the declaration and supporting evidence has been considered but is insufficient to establish diligence from a date prior to the date of reduction to practice of the Stanbach reference (8/6/1999) to either a constructive reduction to practice or an actual reduction to practice.

- The activities described with Burda GmbH, Cyberlab, Mr. Schmetz and Christopher Mackenzie/WPP each appear to be for commercial exploitation ("assistance in implementing software relation to his invention"). None of these persons are inventors. These activities cannot be used to establish the required diligence.
- Examiner points out that paragraphs 12 and 13 of the declaration filed 12/27/04 appears to provide allegations rather than facts.
  - Mr. Schmetz asserts that in spring of 1999, a law firm was contacted to draft and file a provisional patent application [#6, page 2, 7/9/07].

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- Allegations of documents of 8/9/99, 11/2/99, "November 1999", and "December 1999" [#12, page 5, 7/9/07] are insufficient to demonstrate continued diligence and fail to explain the overwhelming lack of activity during the period (5 months) from 8/6/1999 (Stanbach) to 1/6/2000 (applicant's provisional filing).

See MPEP 715.07(a):

*Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.*

*An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See In re Nelson, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.*

See MPEP 2138.06:

*An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) ( 37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).*

It is noted that at no time has applicant stated that "Cyber Lab's Detailed Proposal" (Appendix D) dated "August 1999," is actually a document that existed prior to August 6, 1999 (the date of the Stanbach reference). However, Mr. Schmetz's testimony appears to make this a moot point.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 66, 67, 71, 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- Claim 66, 67, 71, 78 – Examiner has previously rejection the claim under 112 ¶1 for lacking enablement for the web host formatting the personal communication (i.e. original email) pursuant to the recipient device's formatting requirements. Applicant disagreed, but chose to amend claim 66. However claims 66, 67, 71 and 78 still suffer from similar problems. An email delivery system cannot know what type of device the recipient will use to access the email. It could be accessed with POP3, IMAP, a webmail client, an HTML-compliant client, a text-only client, PDA, cell phone, etc. It is not

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clear how one of ordinary skill can accomplish what applicant discloses in the spec and claims. It would be absurd for the email server to re-send an email simply because the recipient chooses to view the email a second time with a different device.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62-66, 68-70, 72-76, 79-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of Andrews (Andrews, Whit, "Panning for Gold in Technology Stocks," Omaha World-Herald, 01/25/1998, pg 55.R)

Regarding claims 68, 69, 72, 75, 76, 81, 82, Stanbach teaches an email server which includes an application to select one of plural stored advertisements and inserts the advertisement (attaches or embeds) into a personal communication message (internet email) composed by a sender to a specified recipient [col 9]. Stanbach does not appear to compensate the participants for the presence of the advertising. Andrews however teaches that Hotmail provided users with free email accounts in exchange for allowing them to include advertising in each email. This was quite a popular "viral marketing" effort and it would have been obvious to have provided the email services of Stanbach for free in exchange for including viral marketing (user to user) advertisements in the delivered emails.

Regarding claims 62-65, 74, 79, 80, 83-87, 89-92, 94, 95, the advertisements are selected automatically by the server application according to the content of the message (keywords are taken to be subject matter) or according to known characteristics of the participants. The automated insertion of advertising into an email is taken to provide creation of an advertisement-enhanced email which is in essence an advertisement. Therefore Stanbach's server is taken to create advertisements based upon content and subject matter.

Regarding claims 66, 78, Stanbach teaches that the server can format the message in a format suitable for the recipient because the server is made aware of the recipient's requirements [col 14 lines 31-39].

Regarding claims 70, 73, Stanbach teaches that the ads may include URLs or HTML inserted into the message body and may link the recipient to more information upon activation/interactions [14:43-47].

Regarding claim 88, 93, Stanbach teaches that the participant can access and edit his profile which is the basis for ad selection. The user may specify the advertisements to be used – this step is taken to read on submission of ad-type data. Further, the user-specified message content determines the ads and therefore the message content (such as keywords) can read on submission of ad-type data. Further, Stanbach teaches that the participants can specify the types of ads that are suitable for insertion [16:26-30].



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**Claims 67, 71, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of Andrews and Camut et al (US6684257).**

Regarding claims 67, 71, Stanbach teaches that the ads may include URLs or HTML inserted into the message body and may link the recipient to more information upon activation/interactions [14:43-47]. Camut et al teaches that it is well known for requesting browser clients to have special data format needs and to identify the requesting browser/client/hardware, transcode the requested data into a preferable format and deliver it to the requesting client for rendering [2:28-43, 3:1-30]. It would have been obvious to have provided the additional requested data in a suitable format for compatibility purposes so that PDA, cell phone, PC, MAC recipients can operatively interact with the emails.

**Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of Andrews and Goldhaber (US5855008).**

Regarding claim 77, Goldhaber teaches the concept of compensating a user who views advertising. It would have been obvious to have compensated the recipient's of Stanbach's emails so that they associate a positive experience with having to view advertising.

### ***Response to Arguments***

Applicant argues that claim 66 has been amended to alleviate the 112P1 problem, yet problems still remain in that and similar claims.

Applicant argues that the previously applied references cannot be used as prior art. Examiner disagrees for the reasons set forth above.

Applicant argues that Andrews differs from the instant invention because users of Andrews do not get to choose the advertising that appears. Awarding a user with free use of email services would have been obvious regardless of whether the ad was chosen by the user or not. Advertising (that is – any advertising, chosen, targeted, or otherwise) is often seen as unwanted, yet for a price users are willing to put up with it. It would have been obvious to one of ordinary skill at the time of the invention to have compensated the user for the burden of the advertising's presence regardless of the choice/content of the advertising.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 3622

  
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